

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte BEVERLY RICHARD

Appeal 2007-0876
Application 10/057,346
Technology Center 1700

Decided: May 29, 2007

Before DONALD E. ADAMS, ERIC GRIMES, and
LORA M. GREEN, *Administrative Patent Judges*.

GRIMES, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 involving claims to antibacterial toilet tissue. The Examiner has rejected the claims as obvious. We have jurisdiction under 35 U.S.C. § 6(b). We affirm.

BACKGROUND

The Specification discloses an antibacterial toilet tissue having a plurality of coupled layers (*id.* at 2; *see also* Figure 2). The layers include upper, intermediate, and lower planar shaped absorbent members; the

intermediate member having a plurality of spaced aligned openings (Specification 2).

“The intermediate member has formed thereon a dry antibacterial member which is activated by moisture” (*id.*). “The antibacterial member . . . , may be made for example, of an antibacterial agent such as for example, Betadine or an antibacterial soap” (*id.* at 4 (as amended August 30, 2004)).

A second embodiment of the disclosed tissue includes only two layers: upper and lower planar shaped absorbent members, with the lower member having a dry antibacterial member on its upper surface (*id.* at 5-6).

DISCUSSION

1. CLAIMS

Claims 1-12 are on appeal. Claims 1 and 7, the two independent claims on appeal, are representative and read as follows:

1. An antibacterial tissue including:

an upper planar shaped absorbent member;

an intermediate planar shaped absorbent member having a plurality of apertures formed therein coupled to the upper planar shaped absorbent member;

an antibacterial member formed on an upper surface of the intermediate planar shaped absorbent member between the upper planar shaped absorbent member and the intermediate planar shaped absorbent member; and

a lower planar shaped absorbent member coupled to a lower surface of the intermediate planar shaped absorbent member.

7. An antibacterial tissue including:

an upper planar shaped absorbent member;

a lower planar shaped absorbent member having a plurality of apertures formed therein coupled to the upper planar shaped absorbent member; and

an antibacterial member formed on an upper surface of the lower planar shaped absorbent member between the upper planar shaped absorbent member and the lower planar shaped absorbent member.

Thus, claims 1 and 7 are directed, respectively, to the three-layer and two-layer antibacterial tissues disclosed in the Specification.

2. PRIOR ART

The Examiner relies on the following reference:

McAtee US 6,280,757 B1 Aug. 28, 2001

3. OBVIOUSNESS

Claims 1-12 stand rejected under 35 U.S.C. § 103 as obvious in view of McAtee (Answer 4).

The Examiner cites McAtee as teaching personal cleansing articles having two outer layers formed of paper fibers having a cleaning substance between the two layers (*id.*, citing McAtee, Figures 4, 5, and abstract). The Examiner points out that “[m]ore than two plies may also be used with any or all of the plies being apertured (col. 6, lines 50-60)” and that “[t]he cleaning substance may be added onto or impregnated into any or all of the surfaces of the different layers, either before or after they are joined (col. 30, lines 45-60)” (*id.*). The Examiner notes that “[a] biocide may be an optional ingredient (col. 30, lines 10-30)” (*id.*).

Based on these teachings, the Examiner concludes that “[i]t would have been obvious to one of ordinary skill in the art to add a bacterial agent from the options given in the reference in order to enhance the[] hygiene of the tissue” (*id.*).

“In proceedings before the Patent and Trademark Office, the Examiner bears the burden of establishing a *prima facie* case of obviousness based upon the prior art.” *In re Fritch*, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992). Because McAtee suggests that it would have been desirable to make articles having the claimed features, we agree that the Examiner has established a *prima facie* case of obviousness.

McAtee discloses “disposable, personal cleansing articles useful for cleansing the skin or hair. . . . The article comprises a water insoluble substrate having a cleansing surface that contains apertures of a certain size and frequency, and a lathering surfactant releasably associated with the substrate” (McAtee, abstract). The insoluble substrate may be made of “commercially available paper layers” (*id.* at col. 5, l. 67 through col. 6, l. 1).

In Figure 5A, McAtee discloses an embodiment having two coupled layers, in which “the wiping article is generally flat prior to wetting” (*id.* at col. 9, ll. 29-30). We agree with the Examiner that McAtee’s two-layered generally flat article meets claim 7’s requirement of two planar shaped members.

McAtee also discloses that “two *or more* plies or layers [may be] used to form the water-insoluble substrate” (*id.* at col. 6, ll. 54-56) (emphasis added). We agree with the Examiner that one of ordinary skill would have

reasoned from this disclosure that a structure having two outer layers and an intermediate layer, as recited in claim 1, would have been obvious in view of McAtee's disclosure.

McAtee also discloses that "[t]he substrates used to form the personal cleansing articles . . . must contain apertures or openings in the cleansing surface of the substrate" (*id.* at col. 6, ll. 25-27), and that "[w]hen two or more plies or layers are used to form the water-insoluble substrate, apertures may or may not be placed in all of the plies or layers" (*id.* at col. 6, ll. 54-57). By disclosing that all of the layers may contain apertures, McAtee therefore meets the limitation in claims 1 and 7, that the intermediate and bottom layers comprise apertures.

McAtee lists "cosmetic biocides" as optional ingredients (*id.* at col. 30, ll. 11-27), and further states that "[t]he surfactant . . . and any optional ingredients can be added onto . . . either layer . . . by any means known to those skilled in the art: for example by spraying, laser printing, splashing, dipping, soaking, or coating" (*id.* at col. 31, ll. 12-17). McAtee also teaches that the layer(s) can be treated before they are joined together (*id.* at col. 30, l. 61 to col. 31, l. 17).

We agree with the Examiner that one of ordinary skill would have reasoned from this disclosure that a biocide would be useful when placed on the top of an intermediate layer in a three-layered article, as recited in claim 1, and on the top of the bottom layer of a two-layered article, as recited in claim 7. We therefore also agree that the antibacterial member recited in claims 1 and 7 would have been obvious at the time the invention was made. *See KSR Int'l v. Teleflex Inc.*, 127 S. Ct. 1727, ___, 82 USPQ2d 1385, 1395

(2007) (“The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.”).

To summarize, because McAtee suggests that products meeting the structural limitations in claims 1 and 7 would have been useful as personal cleansing articles, we agree with the Examiner that one of ordinary skill would have considered those claims to be obvious.

Appellant argues that McAtee does not teach or suggest the three planar members recited in claim 1, including an intermediate member having apertures and an antibacterial agent (Br. 7-8).¹ Similarly, Appellant argues that McAtee does not teach or suggest the two planar members recited in claim 7, including a lower member having apertures and an antibacterial agent (*id.* at 10).

We disagree. For the reasons discussed *supra*, we agree with the Examiner that McAtee would have suggested the limitations of claims 1 and 7 to a person of ordinary skill in the art.

With respect to the upper planar member, Appellant contends that “[t]here is no substantially planar upper member in figure 5A.”

We note that the upper layer of the article shown in Figure 5A has some slight undulations in it. However, McAtee states that “[a]s shown in FIG. 5A, the wiping article is generally flat prior to wetting” (McAtee col. 9, ll. 29-30). We agree with the Examiner that a generally flat article meets the limitations in claims 1 and 7 requiring an upper planar shaped member.

Appellant contends that McAtee discloses that when two or more layers are used to prepare the disclosed article, “[t]he apertures do not

¹ Appeal Brief filed May 11, 2006.

protrude completely through the surface as taught in Applicant's claim" (Br. 8).

We are not persuaded by this argument. Claim 1 recites "an intermediate planar shaped absorbent member having a plurality of apertures formed therein coupled to the upper planar shaped absorbent member." This claim language is most reasonably interpreted to mean that the intermediate member, which has apertures in it, is coupled to the upper member. This interpretation is consistent with the Specification, which states that "[t]he intermediate member is aligned with and coupled to the upper planar member . . ." (Specification 2). Thus, we interpret claim 1 as not requiring the apertures to extend to any surface.

Also, McAtee actually states that the "apertures need not protrude completely through to the surface of the substrate which is opposite to the cleansing surface" (McAtee, col. 6, ll. 52-54). Thus, contrary to Appellant's argument, non-protruding apertures are merely an option for McAtee's multi-layer embodiments, not a requirement.

Appellant argues that claims 2 and 3 are distinguishable from McAtee because there is no teaching or suggestion of including a thin one ply paper absorbent material in the upper planar member (claim 2), or the intermediate planar member (claim 3) (Br. 8-9). Appellant makes the same argument with respect to claims 8 and 9 (*id.* at 11).

We do not agree. McAtee states that the layers comprising the personal cleansing articles may be composed of "commercially available paper layers" (McAtee, col. 5, l. 67 through col. 6, l. 1). We therefore agree

with the Examiner that McAtee suggests using thin one ply paper layers in the personal cleansing articles.

Appellant argues that claim 4 “is distinguishable over the McAtee patent because there is no teaching or suggestion in the McAtee patent of the antibacterial member having a dry antibacterial member” (Br. 9). Appellant makes the same argument with respect to claim 10 (*id.* at 11).

We do not agree. As discussed *supra*, McAtee states that “cosmetic biocides” are useful as optional ingredients (*id.* at col. 30, ll. 11-27), and that “[t]he surfactant . . . and any optional ingredients can be added onto . . . either layer . . . by any means known to those skilled in the art: for example by spraying, laser printing, splashing, dipping, soaking, or coating” (*id.* at col. 31, ll. 12-17). McAtee then discloses that the “the resulting treated substrate is then preferably dried so that it is substantially free of water” (*id.* at col. 31, ll. 19-20). We therefore agree with the Examiner that McAtee suggests using a dry antibacterial member in the personal cleansing articles.

While Claim 10 recites that the “antibacterial member is activated by moisture from the body,” the claim is directed to an article, and not a method in which the article is actually contacted with bodily moisture. Thus, the requirement for activation by body moisture is in the nature of an intended use, and any article capable of performing the intended use will meet that limitation. *See In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997).

As conceded by Appellant, McAtee discloses “a soap and lathering agent that is activated by wetting the article and rubbing the article against itself” (Br. 11). Thus, McAtee’s article can be activated by moisture from

whatever source, including moisture from the body. We therefore agree with the Examiner that McAtee suggests the dried antibacterial member of claim 10.

Appellant argues that claim 11 “is further distinguishable over the McAtee patent because there is no teaching or suggestion in the McAtee patent of an antibacterial tissue wherein the antibacterial member includes a layer of antibacterial soap” (Br. 12). We do not agree.

As pointed out by the Examiner, the lathering surfactant acts as an antibacterial agent in that it removes bacteria from the cleansed surface (Answer 6). Moreover, as has been discussed, McAtee discloses that “cosmetic biocides” are useful components of the personal cleansing article (McAtee, col. 30, ll. 11-27). We agree with the Examiner that these teachings would have made it obvious to use an antibacterial soap in McAtee’s two-layered personal cleansing article.

Appellant argues that “[t]here is also no teaching or suggestion in the McAtee patent of an antibacterial tissue wherein the antibacterial member includes a layer of antibacterial agent as taught in Applicant's claim 12” (Br. 12).

We do not agree. With regard to Appellant’s argument that “[a]ll soaps are not considered as bacterial agents” (Br. 12), it is well settled that argument by counsel cannot take the place of evidence. *In re Cole*, 326 F.2d 769, 773, 140 USPQ 230, 233 (CCPA 1964); *In re Geisler*, 116 F.3d 1465, 1471, 43 USPQ2d 1362, 1365 (Fed. Cir. 1997). Because Appellant does not support this argument with any evidence, we do not find it persuasive. Moreover, because McAtee discloses the usefulness of “cosmetic biocides”

(McAtee, col. 30, ll. 11-27) on the surface of either layer of a two-layered apertured personal cleansing article, we agree with the Examiner that McAtee suggests the desirability of an article meeting all of the structural requirements of claim 12.

SUMMARY

We agree with the Examiner that McAtee teaches that a product having all of the limitations of claims 1-12 would be useful as a personal cleansing article. We therefore affirm the Examiner's rejection of claims 1-12 as being obvious over McAtee.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.R.R. § 1.136(a).

AFFIRMED

dm

KENNETH D. BAUGH
2413 Blodgett
Houston TX 77004